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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/589,217

06/07/2000

David Cooper

13665

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23389

7590

06/07/2011

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EXAMINER

CASCA, FRED A

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

06/07/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/589,217	COOPER, DAVID	
	Examiner	Art Unit	
	FRED CASCA	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28, 29 and 32-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28, 29, 32 and 33-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This Office Action is in response to Amendment filed on 03/17/2011. Claims 28, 29, 32 and 33-39 are still pending. This action is made **Final**.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 28, 29 and 33-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Lynch (US 5,761,618; previously cited).

Regarding claim 28, Lynch discloses a method for user equipment (fig. 7, 101) for a mobile communication system (fig. 7 and col. 13, lines 21-37) comprising:

receiving a message on said user equipment including a first list including a plurality of network identifiers (“downloading an updated preferred SID list to subscriber units” see col. 16, lines 21-46) corresponding to a plurality of available networks available for a potential handover (“The SIDs available for hand-off would be selected and stored” see col. 12, lines 1-5, and Col. 8, lines 40-41, “Another example is found in hand-off situation,” note that the SID can be transmitted in handoff or potential handoff situations),

said receiving from a current active communication network while a call subject to a potential handover, is in progress (Col. 8, lines 40-41, "hand-off situations," Col. 19, lines 25-43, "download SID list when incoming communication," "after communication has begun," "complete a call to the mobile subscriber unit, informing that unit that the SID table is being downloaded through a voice channel" see col. 16, lines 21-46); and

selecting one network of the plurality of available networks to which the user equipment hands over based upon a comparing of said first list with a second list stored in the user equipment ("The received SIDs would be compared to the stored preferred SID list to determine if a preferred SID was available for hand-off" see col. 12, lines 1-5),

wherein said current active communication network signals one or more of the plurality of network identifiers ("downloading an updated preferred SID list to subscriber units" see col. 16, lines 21-46) corresponding to the plurality of available networks for the potential handover ("The SIDs available for hand-off would be selected and stored" see col. 12, lines 1-5), and said receiving of said message occurs without said user equipment searching any communication network ("the current version number is broadcast over the FOCC" see col. 16, lines 21-46).

Regarding claim 29, Lynch discloses User equipment (fig. 7, 101) for a mobile communication network (fig. 7 and col. 13, lines 21-37) comprising:

means for receiving a message that includes a first list including a plurality of network identifiers ("downloading an updated preferred SID list to subscriber units" see col. 16, lines 21-46) corresponding to a plurality of available networks for a potential handover ("The SIDs available for hand-off would be selected and stored" see col. 12,

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lines 1-5 and Col. 8, lines 40-41, “Another example is found in hand-off situation,” note that the SID can be transmitted in handoff or potential handoff situation), from a current active the communication network while a call, subject to a potential handover, is in progress (Col. 8, lines 40-41, “hand-off situations,” Col. 19, lines 25-43, “download SID list when incoming communication,” “after communication has began,” “complete a call to the mobile subscriber unit, informing that unit that the SID table is being downloaded through a voice channel” see col. 16, lines 21-46); and

means for selecting one network of the plurality of available networks to which the user equipment hands over based on a comparing of said first list with a second list stored in the user equipment (“The received SIDs would be compared to the stored preferred SID list to determine if a preferred SID was available for hand-off” see col. 12, lines 1-5), wherein said current active communication network signals one or more of the plurality of network identifiers (“downloading an updated preferred SID list to subscriber units” see col. 16, lines 21-46) corresponding to the plurality of available networks for the potential handover (“The SIDs available for hand-off would be selected and stored” see col. 12, lines 1-5), and said receiving of said message occurs without said user equipment searching any communication network (“the current version number is broadcast over the FOCC” see col. 16, lines 21-46).

Regarding claim 33, Lynch discloses user equipment (fig. 7, 101) for a mobile communication network (fig. 7 and col. 13, lines 21-37) comprising:

a receiver for receiving a message that includes a first list of a plurality of network identifiers (“downloading an updated preferred SID list to subscriber units” see col. 16, lines 21-46) corresponding to a plurality of available networks for a potential handover (“The SIDs available for hand-off would be selected and stored” see col. 12, lines 1-5), from a current active communication network while a call subject to potential handover is in progress (Col. 8, lines 40-41, “hand-off situations,” Col. 19, lines 25-43, “download SID list when incoming communication,” “after communication has began,”

“complete a call to the mobile subscriber unit, informing that unit that the SID table is being downloaded through a voice channel” see col. 16, lines 21-46); and

a selector for selecting one network of the plurality of available networks to which the user equipment hands over based on a comparing of said first list with a second list stored in the user equipment (“The received SIDs would be compared to the stored preferred SID list to determine if a preferred SID was available for hand-off” see col. 12, lines 1-5) wherein said current active communication network signals one or more of the plurality of network identifiers (“downloading an updated preferred SID list to subscriber units” see col. 16, lines 21-46) corresponding to the plurality of available networks for the potential handover (“The SIDs available for hand-off would be selected and stored” see col. 12, lines 1-5), and said receiver receives said message without said user equipment searching any communication network (“the current version number is broadcast over the FOCC” see col. 16, lines 21-46).

Regarding claim 34, Lynch discloses the method for user equipment for a mobile communication system according to claim 28, wherein said message is a dedicated message (“downloading an updated preferred SID list to subscriber units” see col. 16, lines 21-46) for signaling available networks for handover (“complete a call to the mobile subscriber unit, informing that unit that the SID table is being downloaded through a voice channel” see col. 16, lines 21-46. Also see Col. 8, lines 40-41, “hand-off situations,” Col. 19, lines 25-43, “download SID list when incoming communication,” “after communication has began,”).

Regarding claim 35, Lynch discloses the method for user equipment for a mobile communication system according to claim 34, wherein said message is periodically transmitted by said current active network without a specific request (see Col. 8, lines 19-22, “periodically thereafter”, and see Col. 17, lines 61-63, “download can take place periodically,” col. 16, lines 21-46 “the current version number is broadcast over the FOCC”).

Regarding claim 36, Lynch discloses the method for user equipment for a mobile communication system according to claim 28, further comprising the step of: storing said first list in said user equipment (“downloading an updated preferred SID list to subscriber units” see col. 16, lines 21-46).

Regarding claim 37, Lynch discloses the method for user equipment for a mobile communication system according to claim 34, wherein said message includes a special identifier indicating that said message contains a list of available networks for handover ("the current version number is broadcast over the FOCC" see col. 16, lines 21-46).

Regarding claim 38, Lynch discloses the method for user equipment for a mobile communication system according to claim 36, further comprising the step of: receiving, by the user equipment, a second message including at least one network identifier corresponding to a network that is to be deleted from the first list ("set to "zero" for a deletion from the SID list stored in the mobile subscriber unit" see col. 16, lines 21-46).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch in view of Daly (US 6,122,503; previously cited) and further in view of I (US 6,088,335; newly cited).

Regarding claim 32, Lynch discloses a mobile communications network or component (fig. 7 and col. 13, lines 21-37) thereof including:

means for receiving by a user equipment (fig. 7, 101) a message that includes a first list including a plurality of network identifiers (“downloading an updated preferred SID list to subscriber units” see col. 16, lines 21-46) corresponding to a plurality of available networks for a potential handover (see Col. 12, lines 2-9, ‘SIDs available for hand-off,” Also see Col. 8, lines 40-41, “Another example is found in hand-off situation,” note that the SID can be transmitted in handoff or potential handoff situations. “The SIDs available for hand-off would be selected and stored” see col. 12, lines 1-5), from a current active communication network while a call subject to potential handover is in progress (Col. 8, lines 40-41, “hand-off situations,” Col. 19, lines 25-43, “download SID list when incoming communication,” “after communication has began,” Col. 12, lines 2-9, “SIDs available for hand-off,” Also see col. 16, lines 21-46 “complete a call to the mobile subscriber unit, informing that unit that the SID table is being downloaded through a voice channel”);

means for selecting one network of a plurality of networks to which the user equipment hands over based upon a comparing of said first list with a second list stored in the user equipment (“The received SIDs would be compared to the stored preferred SID list to determine if a preferred SID was available for hand-off” see col. 12, lines 1-5);

means for receiving from user equipment communicating with the current active network an indication of a preferred other network (“a mobile subscriber unit sends a code” see col. 16, lines 21-46); and

wherein said current active communication network signals one or more of the plurality of network identifiers (“downloading an updated preferred SID list to subscriber

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units” see col. 16, lines 21-46) corresponding to the plurality of available networks for the potential handover (“The SIDs available for hand-off would be selected and stored” see col. 12, lines 1-5), and said receiving of said message occurs without said user equipment searching any communication network (“the current version number is broadcast over the FOCC” see col. 16, lines 21-46).

But, Lynch does not particularly show said second list including at least one network identifier corresponding to a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list being an identifier of a network that is never to be used (“forbidden” see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the user equipment of Lynch as taught by Daly in order to “control the intelligent roaming function” of the user equipment since the intelligent roaming is “a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in” (see col. 1, lines 20-25 and col. 8, lines 13-15).

But, Lynch and Daly do not particularly show means for supplying neighboring cell information for the preferred other network based on the indication. However in analogous art, I teaches means for supplying neighboring cell information for the preferred other network based on the indication (“base stations of cells in its neighbor list... indicate to the base station (e.g., BS1) the interference levels that that mobile would generate at neighboring base stations (e.g., BS2)” see col. 7, lines 44-63); therefore, it would have been obvious to one of ordinary skill in the art at the time the

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invention was made to modify the user equipment of Lynch and Daly as taught by I for purpose of providing the future cell information which would helps the handoff process more reliable and efficient.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch in view of Hicks (US 6,026,300).

Referring to claim 39, Lynch discloses the method for user equipment for a mobile communication system according to claim 28, and further discloses comparing the received first list with a second list stored in the user equipment (abstract and Col. 16, lines 22-52, "compared to to a preferred SID list").

Lynch does not specifically disclose the second list includes at least one network identifier being an identifier of a network that is never to be used.

However, in the same field of endeavor, Hicks teaches this concept (see Col. 3, lines 45-65, " various service providers are classified as either a Home SP, a Partner SP, a Favorite SP, a Neutral SP, or a **forbidden SP** based on service provider data stored in the mobile station 16. In general, a list of System ID's (SID) and System Operator Codes (SOC) that correspond to the differing levels of service are stored in the mobile station 16. The service provider SID and/or SOC is broadcast on the control channel. On a DCCH, the SID and possibly an SOC are broadcast. On analog control channels, only the SID is broadcast").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the user equipment of Lynch in the format claimed, for

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purpose of preventing costly and expensive networks and thus providing a cost efficient handoff.

Response to Arguments

6. Although the applicant has amended the independent claims that would require new grounds of rejection, the examiner has addressed applicant's arguments to make the rejection clear and eliminate any doubts that the cited prior art teach claimed limitations.

7. Applicant's arguments have been fully considered but they are not persuasive.

In response to arguments that "Lynch fails to teach receiving a message on said user equipment including a first list including a plurality of network identifiers corresponding to a plurality of available networks for a potential handover, said receiving from a current active communication network while a call subject to a potential handover is in progress," the examiner respectfully disagrees and asserts that Lynch clearly teaches the limitation, "receiving a message on said user equipment including a first list including a plurality of network identifiers," col. 16, lines 21-46, which recites ("downloading an updated preferred SID list to subscriber units"). Lynch teaches the limitation, "corresponding to a plurality of available networks for a potential handover," in Col. 12 lines 2-9, which recites ("The SIDs available for hand-off would be selected and stored"). Further, Lynch teaches the limitation, "receiving from a current active communication network while a call subject to a potential handover is in progress," in Col. 12, lines 2-9 and Col. 19, lines 25-40, which recite that ("The time and circumstances during which preferred SID list download may take place is not limited,"

"download a SID list when incoming communication is being established," "SID list downloaded into a subscriber unit handset after communication has begun").

In response to arguments that, "Notably, Lynch teaches downloading a list of updated preferred SID. See Col. 16, lines 21-46. This is not a list of available networks. An available network is not necessarily preferred. Accordingly, for this reason alone, Lynch fails to anticipate the claimed invention," the examiner respectfully disagrees. The examiner asserts that Lynch teaches both "available" and "preferred" networks. Lynch further teaches that the two lists are compared. See Col. 12, lines 2-9, "the SIDs available."

In response to arguments that, "Furthermore, while Lynch teaches that the system will complete a call to the mobile subscriber unit informing that unit that the SID table is being downloaded through a voice channel; the call is not a call subject to a potential handover. In Lynch, the call is part of the updating protocol. It is a special or dedicated call. Lynch states that the network 'complete[s] a call to the mobile subscriber unit informing that the SID table is being downloaded through a voice channel. In fact, a regular call, i.e., call subject to a potential handover, would not be able to be made during the updating since the channels are used by the updating, one for the downloading and the other for the notification," the examiner respectfully disagrees. As an preliminary matter, the examiner asserts that the download of the list through a voice call does not constitute that the call couldn't be in progress because an artisan would understand that while a voice call is in progress, the voice call can still deliver other control signals. Further, Lynch clearly teaches the SID list can be downloaded at

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any time, e.g., while idle, while receiving a call and while a call is in progress (see Col. 12, lines 2-9 and Col. 19, lines 25-40, "The time and circumstances during which preferred SID list is downloaded ... is not limited ... download SID list when incoming communication." Further, based on a broad interpretation of the claimed limitation, the "call subject to handover," is any call because an artisan would understand that any call is subject to "**potential**" handover. Especially, the limitation, "potential" make the limitation broad such that even if there was no mention of handover in Lynch, Lynch could still read on it. But Lynch clearly recites the SIDs for hand-off in Co. 12, lines 2-9. Lynch further teaches, in Col. 8, lines 40-41, "Another example is found in hand-off situation," which implies that the SID is transmitted in handoff or potential handoff situations. Thus, based on a broad interpretation of the claimed limitations, Lynch reads on the above noted limitations.

In response to arguments that, "Notably, Lynch explicitly states that the overhead message can be used to direct subscriber units to tune to another frequency capable of handling the data content of the updated preferred SID list of download. In fact, Lynch states: [o]ne technique for carrying out the updated preferred SID list download to subscriber units would be to send the update information as part of the normal overhead message that all mobile units receive during their normal operation. However, this technique would require changes in the cellular industry standards. This is a long and involved process and may not be considered feasible for the near future. Col. 15, lines 40-49. This suggests that Lynch does not download the list during a call subject to a potential hand over, but rather the download

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occurs when the mobile equipment is idle (other than receiving the notification of the download). In fact, Lynch explicitly teaches away even from having the download during normal overhead messaging. This would also teach away from having the download during normal messaging, i.e., a call subject to a potential handover," the examiner respectfully disagrees.

The examiner asserts that above recitation of Lynch by the applicant has nothing to do with Lynch not downloading the list during a call subject to a potential hand over the examiner asserts that Lynch teaches that "the SID is part of the overhead message that is sent to the mobile subscriber unit when it is powered up, and periodically thereafter." See Col. 8, lines 19-22. Thus, an artisan would understand that the SID download happens during a communication session and also at idle time. The examiner further asserts that, Contrary to applicant's above assertion, Lynch teaches that the SID list downloading happens under any circumstances including during the time when a call is in progress (see Col. 19, lines 25-40). Lynch further teaches that the SID list is downloaded for a hand-off (see Col. 12, lines 2-9). With regards to teaching away, the examiner respectfully disagrees. Lynch's teachings that the SID list can be down loaded under any circumstances including when a call is in progress or when the phone is idle, does not constitute teaching away. However, Lynch does explain the additional steps and procedures that would be required during the downloading of the SID list while a communication is in progress. An artisan would understand that additional procedures required for downloading while a communication is in progress would not constitute teaching away.

In response to applicant's arguments with respect to claim 35 that Lynch does not disclose, "wherein said message is periodically transmitted by said current active network without a specific request," the examiner respectfully disagrees and asserts that Lynch clearly teaches the above claimed limitation in Col. 8, lines 19-22, "mobile subscriber unit when it is powered up, and periodically thereafter" downloads the SID list (see Col. 8, lines 19-22). The examiner further asserts that an artisan would understand that a periodic function would conventionally happen without any "specific" request. Thus, Lynch clearly teaches the claimed limitation.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred A. Casca whose telephone number is (571) 272-7918. The examiner can normally be reached on Monday through Friday from 9 to 5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard, can be reached at (571) 272-7603. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Fred A. Casca/

Examiner, Art Unit 2617

/Patrick N. Edouard/

Supervisory Patent Examiner, Art Unit 2617